

REMARKS

Claims 1, 2, 4-12, 14-23 and 25-27 are pending in the application. Claims 1 and 8 have been amended. Claims 3, 13 and 24 had been previously canceled without prejudice.

Rejection – 35 U.S.C. § 103

Claims 1-2 and 4-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed non-statutory subject matter. Applicant has amended claims 1 and 8 to include various machine based elements and respectfully submits that claims 1 and 8 and therefore dependent claims 2 and 4-7 and 9-11 overcome the rejection based on 35 U.S.C. 101.

Rejection – 35 U.S.C. § 103

Claims 1-2, 5-8, 11-12, 15-23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Celona (U.S. Pat. No. 5,564,700) in view of Green (U.S. Pat. No. 5,538,252) in yet further view of Cannon (U.S. Pat. No. 5,344,144).

The pending application is directed toward a separate side-wager option making player eligible for multi-level progressive awards based on different outcomes from a single play of the basic game. The multi-level progressive award includes the possibility of different progressive awards defined as separate progressive based awards each taken from different pools and each triggered by a different fundamental outcome in the basic game.

A. Green's Multi-Level Progressive Is Ambiguous

As the Office Action notes, Celona does not give the player a separate control to make a separate side-wager, the so-called side-wager in Celona is simply part of the same base wager. (p. 3). Green has been cited as disclosing a “multi-level” progressive jackpot triggered by a side bet (press bet). Applicant respectfully submits that the “multi-level progressive” award in Green

is not defined by the specification and one of ordinary skill would not be able to deduce the mechanics of such an award from the Green specification. At best the multi-level progressive jackpot is described as “the player achieving a desired payable chip or the highest payable chip, receiving all or a portion of the jackpot amount.” (Col. 11, ll. 17-20). Green is silent as to whether the multi-level progressive jackpot is actually two different jackpots driven from different jackpot pools as in the present claims. Applicant respectfully submits that Green’s multi-level jackpots are simply different valued jackpots (desired payable chip or highest payable chip) that are proportional to the player’s press bets and derived from the same jackpot pool, i.e. a \$1 press bet will award one amount, but a \$2 press bet will award double that amount. (Col. 11, ll. 22-25). The Office Action has cited Col. 12, ll. 28-52 of Green as supporting a multi-level jackpot. However, a closer examination of this section reveals that it is a repeat of the sections Applicant has cited above that does not define what a multi-level progressive jackpot is other than an award that may be proportional to the press bet submitted by a player but which is drawn from the same pool. In any case, the same progressive award is triggered for any of joker combinations disclosed in this section of Green.

B. The Improper Combination of Celona, Green and Cannon

Applicant submits that one of ordinary skill would not combine Celona, Green and Cannon. The Office Action has asserted that the different magnitudes of the reserve amounts in the pool would be obvious because of the finite number of solutions. (pp. 5-6). However, Applicant submits that the combination of Cannon to Green would change the fundamental operation of Cannon’s progressive structure and therefore be improper. First, the nature of the multi-level progressive jackpot, as it may be understood, in Green would teach away from the combination of Green with Cannon. As explained above, Green’s conception of a multi-level

progressive jackpot is a variable amount depending on the press chip from the same jackpot pool. In contrast, Cannon discloses different percentage contributions to different jackpot pools. (Col. 4, ll. 13-40). Green also does not specify how the amounts are collected for the jackpot that constitutes the award pool for the multi-level progressive other than a teaching that all press bets form a common pool. One of ordinary skill in the art would not have any motivation to combine a percentage formula method in Cannon assuming multiple jackpot pools to a single progressive award pool as disclosed in Green.

Second, the nature of the progressive award pool in Green is inconsistent with the formulas disclosed in Cannon. Green assembles the progressive pool via a set contribution but does not cap the progressive pool. Green then makes the jackpot payoff proportional to the bet size itself. (Col. 11, ll. 31-45). Thus, Green cannot use the percentage formula in Cannon because the nature of proportional payoff could exceed the amount in the progressive prize pool. Thus one of ordinary skill would not combine Green's prize structure with Cannon because it would change the fundamental nature of operation of Cannon and render the progressive pools inoperable. MPEP 2143.01(VI).

The Office Action has responded that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference" but "what the combined teachings of the references would have suggested to those of ordinary skill." Applicant respectfully submits that the teachings of Green and Cannon would not suggest taking the opposite methods proposed by each reference of a progressive award to one of ordinary skill for the reasons outlined above and therefore the references would not suggest the claims at issue. Further, Applicant respectfully submits that the Office Action has misinterpreted the applicable obviousness standards. The evaluation of obviousness begins with one of several

rationales to combine the cited prior art to arrive at the claims. MPEP 2141(III). In this case, the Applicant's have provided sufficient reasons that there is no rationale to combine Green and Cannon in such a manner to disclose the elements of the pending claims.

C. The Combination of References Does Not Disclose Different Multi-Level Progressive Jackpots Awarded For Different Outcomes In A Single Game

Claims 1, 8, 12 and 26 require that the different multi-level progressive jackpots are awarded for different outcomes (first randomly selected outcome and second randomly selected outcome) of the basic game. The combination of Celona, Green and Cannon would not anticipate these elements because the press bet of Green awards the same jackpot for multiple outcomes in the same game. Celona and Cannon do not teach the availability of a side bet but are focused on single game outcomes to trigger the progressive award. Green does not disclose different jackpots being awarded for different outcomes based on the side bet. The multi-level progressive award from a single game play having a common pool in Green is awarded for all the possible outcomes in Green. The section cited by the Office Action relating to a single game play (e.g. the appearance of jokers) indicates that the same "multi-level progressive" is awarded for any of the outcomes described in Green. (p. 9). In other words, a bet for the "multi-level progressive" from any of the results including a joker would trigger the same progressive award from the same pool. The amount of the progressive award would differ based on the input wager but all of the progressive awards are the same since they are all drawn from the same pool. Thus, the combination of Green and Cannon would not meet the "multi-level" progressive jackpots that award different progressive jackpots as required by the claims because the combination would have a single award triggered by the joker combinations in Green.

Conclusion

It is the Applicant's belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicant's undersigned attorney at the number shown.

Respectfully submitted,

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